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The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte DAVID A. GLOWNY,  
COLETTE A. MASTRANGELO,  
PAUL M. MAYER  
and CARYL M. RAHN

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Appeal No. 94-4400  
Application 07/771,063<sup>1</sup>

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ON BRIEF

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Before HAIRSTON, JERRY SMITH and FLEMING, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed October 2, 1991.

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 10-20, which constitute all the claims remaining in the application.

The claimed invention pertains to a method for handling requests on a network between several client nodes and at least a pair of control point nodes. At any point in time, one control point node acts as the primary control point node while the other control point node acts as an alternate control point node.

Representative claim 10 is reproduced as follows:

10. In a network having a client node and a pair of control point nodes operable as servers to the client node, each control point node functioning as either a primary control point node or an alternate control point node, a method for establishing one of the control point nodes as a primary control point node to the client node, comprising the steps of:

(a) interrogating each control point node from the client node to determine its status as a primary or alternate control point node; and

(b) at each control point node, in response to being interrogated by the client node:

(1) if the node is a primary control point node, advising the client node of the status of the control point node as a primary control point node;

(2) if the node is an alternate control point node, interrogating the other control point node for information regarding its status as a primary or alternate control point node;

(3) in response to the receipt of status information indicating that the other control point node is a primary control point node, advising the client node of the status of the interrogating control point node as an alternate control point node, otherwise,

Appeal No. 94-4400  
Application 07/771,063

changing the status of the interrogating node to that of a primary control point node.

The examiner relies on the following references:

Literati et al. (Literati)	4,939,752	July 03, 1990
Near et al. (Near)	5,068,877	Nov. 26, 1991
		(filed Apr. 02, 1990)

Claims 10-20 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Near in view of Literati.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

#### OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the collective evidence relied upon and the level of skill in the particular art would not have suggested to one of

Appeal No. 94-4400  
Application 07/771,063

ordinary skill in the art the obviousness of the invention as set forth in claims 10-20. Accordingly, we reverse.

Appellants have indicated that for purposes of this appeal the claims will stand or fall together in the following

three groups: Group I has claims 10-12, Group II has claims 13-16, and Group III has claims 17-20. Consistent with this indication appellants have made no separate arguments with respect to any of the claims within each group. Accordingly, all the claims within each group will stand or fall together. Note In re King, 801 F.2d 1324, 1325, 231 USPQ 136, 137 (Fed. Cir. 1986); In re Sernaker, 702 F.2d 989, 991, 217 USPQ 1, 3 (Fed. Cir. 1983). Accordingly, we will only consider the rejection against claims 10, 13 and 17 as representative of all the claims on appeal.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one

Appeal No. 94-4400  
Application 07/771,063

having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438

(Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

With respect to claim 10, the key recitations reside in clauses (b)(2) and (b)(3). Appellants argue that "neither reference suggests having an alternate node, upon being queried, first determining the existence of a primary node in the system before reporting back its status as an alternate node, nor do

they suggest having the alternate node upgrade its status to that of a primary node upon failing to determine the existence of such a primary node" [brief, pages 10-11]. The examiner does not respond to this argument directly, but instead, argues that the invention of claims 10-12 is suggested by the applied prior art because the primary master node in Literati checks with other nodes through the transfer of timing priority numbers (TPNs), and the checking and incrementation of the TPNs clearly teaches the checking of the status of each node [answer, page 6]. Although it is not clear if any of the examiner's statements regarding the teachings of the applied prior art are incorrect, it is clear that the examiner's rejection fails to address the specific recitations of claim 10 and whether the differences asserted by appellants would have been obvious to the artisan in view of this prior art.

As pointed out by appellants, the method of claim 10 specifically recites an alternate control point node which interrogates other control point nodes and updates its own status to a primary control point node when it does not find a primary control point node among the other control point nodes. The examiner apparently views the "client" nodes of Near and Literati as interrogating each of the control point nodes, and the

"control" nodes of Literati as interrogating each other because, in both cases, all the nodes learn of each other's status by way of the TPNs. Although we agree that the control point nodes in the applied prior art learn of the status of other control point nodes by way of derived information, we cannot agree that the interrogations as recited in claim 10 are suggested by Near or Literati. In our view, the step of interrogating requires some form of official or formal request to be made from one element to another. The mere power to deduce what is going on within the network does not constitute an interrogation as disclosed and claimed.

There is no question that the nodes in Near and Literati directly communicate only with nodes that are connectable by a single link. That is, node G directly communicates with both second master node H and third master node E whereas node F does not directly communicate with any of the three master nodes [see FIG. 2 of Literati]. None of the master nodes directly communicate with any other master node. In our view, the fact that any node in Literati can be traced to any other node by an appropriate selection of links does not imply that an interrogation occurs between those links. For example, second master node H in Literati derives information about the status of

first master node A from the information sent along the sequence of links numbered 201, 202, 205, 208 and 209. Although the information received on link 209 contains information about first master link A, the information is sent without any interrogation by the other control nodes. We see a basic difference between a node sending information about its condition at all times and a node being specifically interrogated by a different specific node to report its status as a primary or alternate control node.

As an analogous example of this point, suppose that person A communicates information to person B, and person B passes this information on to person C. Although person C

becomes aware of the information that person A told person B, person C never interrogated person A to get this information. The information was derived by a totally separate channel. Likewise in the applied prior art, information contained on any one link may contain information that was present on other links but such information was not obtained by an interrogation of links not directly connected.

Although this distinction may seem trivial to some, it forms the crux of appellants' arguments regarding the patentability of claim 10. We are not willing to interpret claim



10 in a manner which would relieve the examiner of the burden of explaining why this distinction between the claimed invention and the applied prior art would have been obvious to the artisan. We view the distinction as pointed out by appellants to be real and worthy of an appropriate analysis within the meaning of Section 103. Since the examiner basically has not treated this distinction as a difference between the claimed invention and the applied prior art at all, we conclude that the applied prior art and the analysis provide by the examiner fail to establish a prima facie case of the obviousness of claim 10. Therefore, we do not sustain the rejection of claims 10-12.

With respect to claim 13, the key recitations reside in clause (b)(2). Appellants argue that the method of claim 13 precludes a higher priority node from taking control away from a node that already properly has the primary status. Appellants argue that the scheme in Literati always transfers control back to a higher priority control node whenever it is brought back on line, and thus Literati actually teaches away from the claimed invention [brief, pages 11-12]. The examiner explains the operation of the priority scheme in Literati but does not

directly address the point made by appellants [answer, pages 6-8]. We are of the view that the applied prior art does not perform the method recited in claim 13 and does not provide any suggestion for the implementation of the method of claim 13.

Claim 13 recites that "if the priority of the transmitting node is higher than that of the receiving node and the receiving node is not already a primary node, establishing the receiving node as an alternate node..., otherwise, establishing the receiving node as a primary node" [underlining added for emphasis]. Thus claim 13 recites that a node not having higher priority would continue as the primary node as long as it obtained the primary node status at some point. Thus, a request from a higher priority node for control would be ignored by a

lower priority node that already has control. The applied prior art cannot achieve this operation because the applied prior art is designed to always allow the node with highest priority to take control whenever such a node comes on line.

The examiner has not explained why this distinction between the invention of claim 13 and the applied prior art would have been obvious to the artisan. As we noted above, although

Appeal No. 94-4400  
Application 07/771,063

this distinction may seem trivial to some, it forms the crux of appellants' arguments regarding the patentability of claim 13. Since the examiner again has not treated this distinction as a difference between the claimed invention and the applied prior art at all, we conclude that the applied prior art and the analysis provide by the examiner fail to establish a prima facie case of the obviousness of claim 13. Therefore, we do not sustain the rejection of claims 13-16.

Since claims 17-20 depend from claim 13 and include all the limitations of claim 13, the rejection as applied by the examiner against these claims also fails for the same reasons discussed above with respect to claim 13. Therefore, we do not sustain the rejection of claims 17-20.

In summary, we have not sustained the examiner's rejection against any of the claims. Accordingly, the decision of the examiner rejecting claims 10-20 under 35 U.S.C. § 103 is reversed.

REVERSED

Appeal No. 94-4400  
Application 07/771,063

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Administrative Patent Judge	)	
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